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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,407	06/22/2001	Michael Thoms	011106	2625

22876 7590 10/19/2004

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EXAMINER
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GAGLIARDI, ALBERT J

ART UNIT	PAPER NUMBER
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2878

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/869,407

Applicant(s)

THOMS, MICHAEL

Examiner

Albert J. Gagliardi

Art Unit

2878



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-12, 14, 15, 17-24 and 26-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-12, 14, 15, 17-24 and 26-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3 August 2004 has been entered.

### ***Specification***

2. The disclosure is objected to because of the following informalities: The disclosure includes numerous references to particular claims; however, the subject matter referred thereto does not seem to match the description.

Extensive and appropriate correction is required.

### ***Claim Objections***

3. Claim 35 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 35 is dependent on a canceled claim (claim 5).

4. Claim 37 is objected to because of the following informalities:

In line 4, one of the expression "selecting a" should be deleted. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-4, 6-12, 14 and 35 (as best understood), claims 15, 17-20, claims 21-24, 26-34, claim 36, and claim 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The examiner notes that the above claims, either directly, or through their dependency, include limitations relating to “crystal clear” components and “isotropic refractive indices”. There appears to be no basis in the description for such limitations.

7. Claims 1-4, 6-12, 14 and 35 (as best understood), claims 15, 17-20, claims 21-24, 26-34, claim 36, and claim 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The examiner notes that while the claims include limitations wherein the storage particles and binding agents are isotropic, there is no description in the specification of any of the particular storage particles or binding agents that meet the criteria. Additionally there is no disclosure of even a single specific example of a flat storage panel that reads on the claims as presently amended. The examiner notes that while there are extensive lists of materials for both binding agents and storage particles, it is not clear which, if any, of the particular materials and/or their combinations results has an isotropic refractive index.

Note: If it is considered that all of the listed materials meet the claimed criteria (i.e., they are all isotropic in nature), the examiner would consider the claims as enabled, however if only some of the materials meet the claimed criteria, and there is no discernable way of knowing which materials are suitable, the examiner would consider the disclosure as not being enabling, but merely an invitation to experiment.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sieber *et al.* (US 5,693,254).**

Regarding claim 37, *Sieber* suggests a method for producing a storage element for an x-ray image comprising selecting a binding agent (col. 3, lines 53-57), selecting a first and second salt material which are chemically different, but crystallizing in the same crystal structure wherein the first and second salts have refractive indexes lower and higher (obvious, if not inherent aspect of the invention in view of the ability to adjust the index of refraction by varying the concentration of components) than the refractive index of the binder (see, for example, col. 4, lines 17-34; col. 6, lines 8-24; and col. 9, lines 12-14); and mixing the two salts to form a mixed crystal in a proportion such that the refractive index of the mixed crystal matches that of the binding agent (col. 9, lines 3-25).

***Response to Arguments***

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10. Applicant's arguments, see response filed 3 August 2004, with respect to claims 1-4, 6-12, 14 and 35 (as best understood), claims 15, 17-20, claims 21-34, and 36, and claim 38 have been fully considered and are persuasive. The 35 USC 103 rejections have been withdrawn.

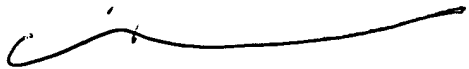
Claims 1-4, 6-12, 14 and 35 (as best understood), claims 15, 17-20, claims 21-24, 26-34, claim 36, and claim 38 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.

***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Albert J. Gagliardi whose telephone number is (571) 272-2436. The examiner can normally be reached on Monday thru Friday from 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Albert J. Gagliardi  
Primary Examiner  
Art Unit 2878

AJG